

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|-------------|--------------------------------|---|-----------------|------------------|
| Applicant: | Jeremy John Carroll | § | Group Art Unit: | 2625 |
| | | § | | |
| Serial No.: | 10/632,132 | § | | |
| | | § | Examiner: | Kassa, Hilina S. |
| Filed: | 07/30/2003 | § | | |
| | | § | | |
| For: | Reconfiguration of a Computer- | § | Atty. Dkt. No.: | 30980156-2 |
| | based Printing System | § | | (HPC.0721US) |

Mail Stop Appeal Brief-Patents

Commissioner for Patents

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REPLY BRIEF

Sir:

The following sets forth Appellant's Reply to the Examiner's Answer dated September 11, 2009.

A. REPLY TO EXAMINER'S ANSWER REGARDING § 112, ¶ 1, REJECTION OF CLAIM 14

With respect to claim 14, the Examiner alleged that the phrase "computer readable media" is not supported by the specification, and therefore, lacks adequate written description.

As pointed out in the Appeal Brief, page 10 and Figure 1 of the specification shows several personal computers 2, 3, 4, and explains that each personal computer has a system unit 14 and software running in each of system unit 14 to perform various tasks. A person of ordinary skill in the art would understand that for software to function within a system unit of a computer, such software has to be first stored on computer readable media, such as memory.

It is noted that the M.P.E.P. specifically provides that to satisfy the written description requirement, what is conventional or well known to one of ordinary skill in the art need not be

disclosed in detail. M.P.E.P. §2163 (8th ed., Rev. 8), at 2100-180. As provided by the M.P.E.P., if a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claim is not explicitly described in the specification, then the written description requirement is met. *Id.*

In this case, a person of ordinary skill in the art would clearly have understood that personal computers with software would include computer storage media on which the software is stored.

In view of the foregoing, it is respectfully submitted that claim 14 complies with the written description requirement, and therefore, reversal of the § 112, ¶ 1, rejection is respectfully requested.

B. REPLY TO EXAMINER'S ANSWER REGARDING THE § 101 REJECTION OF CLAIM 14

The Examiner continues to incorrectly characterize the subject matter of claim 14 as being **nonfunctional** descriptive material. 09/11/2009 Examiner's Answer at 23. It is clear that the computer program of claim 14 constitutes **functional** descriptive material. As provided by the M.P.E.P. § 2106.01, when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. M.P.E.P. § 2106.01, at 2100-17.

In view of the foregoing, it is respectfully submitted that claim 14 is clearly directed to statutory subject matter, and reversal of the § 101 rejection is respectfully requested.

C. REPLY TO EXAMINER'S ANSWER REGARDING THE § 103 REJECTION OF CLAIMS 1, 2, 5, 7-11, 14

As explained in the Appeal Brief, even if Owa and Van Oijen could be hypothetically combined, the hypothetical combination of the references would not have disclosed or hinted at the following combination of elements of claim 1:

- iii) when one or more of the print jobs cannot be printed using said at least one printer on the basis of said plurality of different printing configurations, automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said one or more print job(s); and
- iv) performing such a reconfiguration of the printer configuration automatically or providing information to enable such a reconfiguration to be carried out manually.

The Examiner conceded that Owa fails to disclose “automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said one or more print job(s),” and “performing such a reconfiguration” 1/21/2009 Office Action at 9. Instead, the Examiner cited Van Oijen as purportedly disclosing the claim features missing from Owa.

The Appeal Brief sets forth reasons regarding why the recited passages of Van Oijen have nothing to do with the claimed features conceded to be missing from Owa.

In the Examiner's Answer, additional passages of Van Oijen were cited by the Examiner: column 4, lines 29-42; column 6, lines 1-29. The cited column 4 passage of Van Oijen states that a check is made regarding whether a print job size is such that it must be characterized as a “long job.” If a print job does not satisfy a print criterion, then the job can be given a marker in the memory related to the property of the job which does not satisfy the criterion. The jobs present in the memory can be displayed, and the marker is shown to indicate to the operator why a specific job has not been printed.

Marking a job that does not satisfy a print criterion and displaying such job to an operator has nothing to do with “automatically determining at least one **reconfiguration of the printer configuration(s)** that would be capable of **satisfying the printing requirement(s) of said one or more print job(s).**”

The cited column 6 passage of Van Oijen also states that when a job is not carried out, a marker is displayed to inform the operator of the reason why the job has not been carried out. Again, this has nothing to do with the claimed subject matter.

In view of the foregoing and in view of the reasons set forth in the Appeal Brief, it is clear that the foregoing claims are non-obvious over Owa and Van Oijen.

D. REPLY TO EXAMINER’S ANSWER REGARDING THE § 103 REJECTION OF CLAIMS 18, 19

Claim 18 further recites that the at least one reconfiguration of the printer configuration(s) capable of satisfying the printing requirement(s) of the print job(s) is determined by automatically analyzing a set of possible reconfigurations. In the Appeal Brief, Appellant explained why the passage of Owa cited in the final Office Action does not support the rejection. In the Examiner’s Answer, the Examiner cited a new passage of Owa, namely column 6, lines 22-27. This passage of Owa relates to checking whether or not the basic information on each printer to be selected can satisfy a user print condition. It has nothing to do with the subject matter of claim 18, which recites that the at least one reconfiguration of the printer configuration(s) capable of satisfying the printing requirement(s) of the print job(s) is determined by automatically analyzing a set of plausible reconfigurations.

Therefore, reversal of the rejection of the above claims is respectfully requested.

E. CONCLUSION

Other arguments presented in the Examiner's Answer are rebutted by the Appeal Brief. In view of the arguments presented above and in view of the arguments presented in the Appeal Brief, reversal of all final rejections is respectfully requested.

Respectfully submitted,

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